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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/421,953 10/20/99 MARSHALL

C UV-303

TM02/1108

EXAMINER

G VICTOR TREYZ
FISH & NEAVE
1251 AVENUE OF THE AMERICAS
NEW YORK NY 10020-1104

KOSTAK, V

ART UNIT PAPER NUMBER

2611

DATE MAILED:

11/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

| | |
|-------------------------------|---------------------------------|
| Application No. 09/421,953 | Applicant(s) Marshall et al. |
| Examiner Victor R. Kostak | Group Art Unit 2611 |

Responsive to communication(s) filed on _____

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) 15-27 is/are allowed.

Claim(s) 1-14 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al., cited by applicant. Applicant is informed that the examiner is aware that claim 1 is identical to original claim 1 of parent serial # 08/974,994, which was already dealt with. Claim 1 in the instant application has accordingly been identically treated.

Davis (Fig. 12) discloses elements 245, 220 and 240 which correspond to applicants' receiver and tuner, and provides numerous program guide manipulation and display options (e.g. col. 3 lines 13-59) including control of fading, which he further describes fading as an improvement over well-known scrolling (col. 9 lines 32-38).

Although he does not describe fading as a transparency, one of ordinary skill in the art would have recognized that fading is characterized as a gradual change in intensity, ultimately reaching an invisible state, which effectively assumes a transparent condition (it is noted that applicants' transparency is total, which would result in an invisible overlay), thereby meeting claim 1.

As for claim 12, the program guide data transmitted from the headend is in software form and processed for reproduction as displayed data (e.g. Fig. 2C).

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As for claim 13, the tuner receives the program data as well as the programs (note Fig. 12).

As for claim 14, the receiver includes a user device for sending commands for altering the display (col. 21 lines 19-24).

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1; 1; 10 and 11; 8 and 10; 9; 1; 2; 3; and 4; respectively, of U.S. Patent No. 6,020,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because, firstly regarding instant claim 2, the difference between "superimposed" and "simultaneous" display in the same context is inconsequential, and display of more broadly recited "information" (rather than program guide data, which is later recited as "schedule information" is also inconsequential.

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As for instant claims 3, the recited "schedule" information is equivalent to the "program guide" data recited in patented claim 1, mentioned above.

The listing in grid form as recited in instant claim 4 is covered in patented claims 10 and 11.

The grid comprising TV channels so recited in claim 5 is accounted for in patented claims 8 and 10.

The grid listing of broadcast times is also recited in patented claim 9. Having them in a collinear (i.e. one-dimensional) arrangement as claim 6 recites is very typical.

As for instant claim 7, translucence or opacity is a natural characteristic of semi-transparency.

As for claim 8, weighted transparency is covered in claim 2 of the patent.

As for claim 9, user selection of weighting is also accounted for, in patent claim 3.

Regarding claim 10, user selected weighting indication is covered in patented claim 4.

3. Claims 15-27 appear allowable over the prior art.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor R. Kostak whose telephone number is (703) 305-4374. The examiner can normally be reached on Monday - Friday from 6:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew I. Faile, can be reached on (703) 305-4380.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306 (For either formal or informal communications intended for entry. For informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**Victor R. Kostak
Primary Examiner**

VRK

VRK

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November 4, 2000